

Serial No. 09/725,294
Docket No. 11P338920

REMARKS

Entry of this Amendment is proper because it narrows the issues on appeal and does not require further search by the Examiner.

Claims 1-20 are all the claims presently pending in the application.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Claims 1, 7, 19-20 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Jokimies, et al. (U.S. Patent No. 6,526,267). Claims 2-6 and 8-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jokimies, in view of Kraft, et al. (U.S. Patent No. 6,463,278)

These rejections are respectfully traversed in the following discussion.

I. THE CLAIMED INVENTION

The claimed invention is directed to a radio communication terminal, which, during a waiting operation receives broadcast data from a plurality of base stations to determine a current presence position.

A storing unit stores broadcast data and reception levels received from a plurality of base stations, as registered data that defines a registered presence position when the radio communication terminal is located at a preset presence position. A comparing means compares, during the waiting operation, a currently-received broadcast data and reception levels with the registered data in the storing unit. The comparing means includes a capability to determine that at least one of the number of the base stations or the reception level from the base stations is changing frequently.

Conventional radio terminals that have a capability to determine a current presence position do not include the capability to detect and recognize rapid changes in the parameters that define a current presence position.

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The claimed invention, on the other hand, includes a feature that monitors the change in the number of currently-received base stations and/or reception levels from these base stations, as described beginning at line 19 of page 15 of the specification. This information is used to detect the high speed travel mode, described in claims 6 and 12-18.

II. THE PRIOR ART REJECTIONS

A. The Rejection Based on Anticipation by Jokimies

The Examiner alleges that Jokimies teaches the claimed invention described by claims 1, 7, 19, and 20. Applicant submits, however, that there are elements of the present invention described in these claims which are neither taught nor suggested by Jokimies.

More specifically, whatever similarities that the present invention might share with Jokimies, Applicant submits that this reference fails to teach the method of constantly searching for current presence position during "waiting operations", meaning periods during which the radio communication terminal is not actively engaged in a current transmission event (e.g., waiting for a call).

Indeed, beginning at line 66 of column 3, it is clear that Jokimies clearly teaches to search for current presence position only during power-up and at the beginning of each call. Therefore, Jokimies clearly teaches against using waiting periods as the time periods for performing the detection of current presence position, let alone a constant search for the current presence position.

As Applicant has already explained, the reason that Jokimies uses an entirely different technique is because, as clearly explained at lines 33-43 of column 3, the purpose in this reference is merely to determine whether the user is currently in the "home area" where the tariffs and services of this home area would thereby apply during that call.

Moreover, Jokimies fails to teach or suggest the capability to detect and set the high speed travel mode, during which the number of the received base stations and/or the reception levels are changing rapidly. Applicant submits that the express purpose of Jokimies of being able to merely detect the home area clearly precludes any motivation to detect such changes in number/reception level of base stations.

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Hence, turning to the clear language of the claims, in Jokimies there is no teaching or suggestion of: "... comparing means for comparing, during said waiting operation, a currently-received broadcast data and reception levels with said registered data in said storing unit, said comparing means including a determining means for determining that at least one of a number of said base stations and a reception level from said base stations is changing frequently...", as required by claim 1. The remaining independent claims have similar language.

Therefore, Applicant submits that there are elements of the claimed invention that are not taught or suggest by Jokimies. Therefore, the Examiner is respectfully requested to withdraw this rejection.

B. The Rejection Based on Kraft

The Examiner alleges that Jokimies, further in view of Kraft, renders obvious the present invention defined by claims 2-6 and 8-18. Applicant respectfully disagrees.

That is, Applicant submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention.

Kraft discloses a portable phone that detects various parameters to automatically set different pre-defined modes. The Examiner is understood as conceding that Jokimies fails to teach or reasonably suggest the automatic setting of modes. To overcome this deficiency, the Examiner relies upon Kraft, alleging that "... it would have been obvious to one skilled in the art at the time of invention to have included into Jokimies' detection setting, Kraft's automatic present function provisions, for the purposes of automatically setting user preferences in accordance with different environments (ie meetings,, car use, ect.), as taught by Kraft."

However, Applicant respectfully submits that these references would not have been combined as alleged by the Examiner and, even if combined, would not overcome the above-identified deficiencies of Jokimies. Indeed, these references are directed to different matters.

Specifically, as explained above, the purpose of Jokimies is to determine whether the user has available the tariffs and services of the home area for the call currently being

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made. There would be no reasonable need or rationale to set the phone into a specific mode for this purpose.

That is, in the rejection currently of record, the Examiner applies the incorrect legal standard in summarily declaring that the motivation to modify Jokimies is merely to obtain the benefit of having made the modification. As clearly stated in MPEP §2143.01: *"The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."* (emphasis in MPEP itself)

Using the Examiner's rationale, everything would be rendered obvious, since the reason to modify a reference simply becomes the circular reasoning that one would be motivated to modify the reference for the purpose of obtaining the benefit of having made the modification.

Applicant submits that it is the prevention of this circular reasoning that motivated Judge Rader to write in the recent Federal Circuit Court of Appeals holding in *Ruiz v. A.B. Chance Co.*, Federal Cir., No. 03-1333, January 29, 2004:

"In making the assessment of differences, section 103 specifically requires consideration of the claimed invention 'as a whole.' Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that 'virtually all [inventions] are combinations of old elements.'). The 'as a whole' instruction in title 35 prevents evaluation of the invention part by part. Without this important requirement, an obviousness assessment might break an invention into its component parts (A + B + C), then find a prior art reference containing A, another containing B, and another containing C, and on that basis alone declare the invention obvious. This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention."

Although the holding in that case left undisturbed, under the "clear error" standard of review, the conclusion of the District Court that the prior art references were properly combinable, it specifically explained that it declined to reverse this conclusion because "... the two references address precisely the same problem ..." (emphasis by Applicants)

This aspect of the *Ruiz* holding, in which precisely the same problem is being addressed by two prior art references is not present in Jokimies and Kraft, as already mentioned above.

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Second, even if Jokimies were to be modified to incorporate the automatic mode setting capability described in Kraft, the combination would not provide the capability to detect rates of changes in the number/reception levels of currently-received base stations. This capability provides the basis to detect the high speed travel mode, as described in claims 6 and 12-18.

The closest analogy that Kraft has for detecting the high speed travel mode is the carkit detector 15, but this detector is based on an entirely different concept.

Therefore, Applicant submits that Kraft clearly fails to overcome the deficiencies of Jokimies and that all claims are clearly patentable over these two references, either alone or in combination.

III. FORMAL MATTERS AND CONCLUSION

In view of the foregoing, Applicant submits that claims 1-20, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

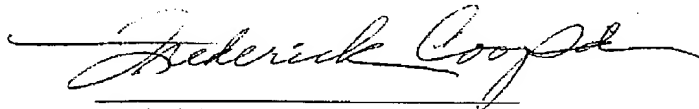
Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: _____

9/24/04



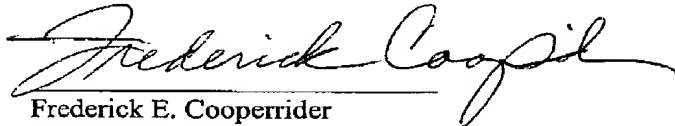
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CERTIFICATION OF FACSIMILE TRANSMISSION

I hereby certify that I am filing this Amendment Under 37 C.F.R. §1.116 by facsimile with the United States Patent and Trademark Office addressed to Examiner Tanmay S. Lele, Group Art Unit 2684 at fax number (703) 872-9306 this 24th day of September, 2004.


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